

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 10-16 and 19-40.

The following claims are *independent*: 10, 19, 28 and 32.

The following claims have previously been *cancelled* without prejudice or disclaimer: 1-9.

Please *cancel* the following claims without prejudice or disclaimer: 17-18.

Please *add new* claims 19-40 and please *amend* claims 10-12, 15 and 16; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification, figures and claims and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 102

The Office Action and the Examiner's Answer rejected previously pending claims 10-14 and 16-18 under 35 U.S.C. § 102(a and e) as anticipated by Dirksen et al., US Patent No. 6,853,975 (hereinafter "Dirksen").

While Applicant continues to maintain the arguments filed in the previously filed Amendment After Final (dated January 12, 2006) and Appeal Brief (dated March 2, 2006), Applicant disagrees with the Examiner's assertion that Dirksen is a proper 102 (a) and (e) reference. Accordingly, Applicant requests further clarification as to how the cited reference qualifies as both 102 (a) and 102 (e) reference. Without conceding that Dirksen is a proper 102 (a) and (e) reference, Applicant has amended independent claim 10, cancelled claims 17-18 and added additional claims 19-40. In light of these amendments, Applicant submits that Dirksen does not anticipate or render obvious every element of the pending claims.

Applicant submits Dirksen does not anticipate or render obvious at least the following elements as recited, *inter alia*, in amended independent claim 10:

A computer system implemented method for conducting an employee performance review, comprising:

transmitting by a computer system a preloaded list of reviewees, wherein the list is generated based on substantial employment related interaction during a relevant review period of time;

receiving one or more reviewee selection from the transmitted preloaded list whose employment performance a user desires to review;

...

The Examiner's Answer asserts that the previously pending claimed elements are discussed in Dirksen (col. 4, lines 55 - 61, col. 5, lines 1-25) and alleges:

As per claim 10, Dirksen et al teaches selecting, by a user of the system, a person whose employment performance the user desires to review ... (col. 4, lines 55-61 - the users initiate the rating process and select the name of the person they want to rate...) (Examiner's Answer, p. 3).

Applicant disagrees with the Examiner's characterization of the cited reference as applied to the previously pending claims and submits that the reference does not anticipate or render obvious the claims as amended.

In contrast to the pending claims, Applicant submits that Dirksen discusses *employees selecting their own reviewers as "rater nominees."* For example, Applicant notes that Dirksen discusses, "...the ratee and manager discuss and agree on raters ... the ratee (employee being rated) identifies or updates raters on a web-based rater nomination form ..." (Dirksen, col. 3, line(s) 9 - 12). The manager then receives the list of the employee's *rater nominees* and approves or disapproves the nominations. Applicant notes that Dirksen discusses, "... once the rater nominations have been submitted and approved by the manager, the approved raters may initiate the rating process ..." of the requesting employee (Dirksen, col. 4, lines 8 - 11). Applicant also notes that according to Dirksen, the ratees/employees may solicit nomination from raters which are "... direct managers and matrix managers..." (Dirksen, col. 4, lines 41 - 43).

As such, Applicant submits that Dirksen's ratee/employee selected reviewers are fundamentally different from the claimed "... transmitting by a computer system a preloaded list of reviewees, wherein the list is generated based on substantial employment related interaction during a relevant review period of time ..." as explicitly recited in amended independent claim 10.

Furthermore, Dirksen's ratee/employee selected review system also fails to discuss the claimed "... receiving one or more reviewee selection from the transmitted preloaded list

whose employment performance a user desires to review ...” also recited in amended independent claim 10 (emphasis added).

Accordingly, Applicant submits that Dirksen fails to discuss or render obvious the claimed elements of independent claim 10. For at least the reasons discussed above, Applicant submits amended independent claim 10 is patentably distinct from the cited reference.

Although of different scope than claim 10, Applicant submits that claim 19 is also patentable over Dirksen. For example, independent claim 19 recites, *inter alia*,

A computer system implemented method for conducting employee performance reviews, the method comprising:
 identifying by a computer system one or more interactions during an evaluation period between a reviewer and one or more reviewees based on overlapping projects and clients;
 preloading by the computer system a list of the reviewees related to the identified interactions;
 receiving by the computer system a selection of reviewees from the preloaded list;
 ...

Applicant respectfully submits that at least these claim elements from independent claim 19 are not anticipated or rendered obvious by Dirksen, for at least similar reasons as discussed above identifying deficiencies in the applied reference with regard to independent claim 10. Accordingly, Applicant respectfully submits that claim 19 is also patentably distinct from the cited reference.

Although of different scope than claim 10, Applicant submits that claim 28 is also patentable over Dirksen. For example, independent claim 28 recites, *inter alia*,

A computer system for conducting employee performance reviews, comprising:

a memory;

a processor disposed in communication with the memory and configured to issue a plurality of processing instructions stored in the memory, wherein the processor issues further instructions to:

transmit a preloaded list of reviewees, wherein the list is generated based on substantial employment related interaction during a relevant review period of time;

receive one or more reviewee selection from the transmitted preloaded list whose employment performance a user desires to review;

...

Applicant respectfully submits that at least these claim elements from independent claim 28 are not anticipated or rendered obvious by Dirksen, for at least similar reasons as discussed above identifying deficiencies in the applied reference with regard to independent claim 10. Accordingly, Applicant submits that independent claim 28 is also patentably distinct from the cited reference.

Although of different scope than claim 10, Applicant submits that claim 32 is also patentable over Dirksen. For example, independent claim 32 recites, *inter alia*,

A computer system for conducting employee performance reviews, the system comprising:

a memory;

a processor disposed in communication with the memory and configured to issue a plurality of processing instructions stored in the memory, wherein the processor issues further instructions to:

identify one or more interactions during an evaluation period between a reviewer and one or more reviewees based on overlapping projects and clients;

preload a list of the reviewees related to the identified interactions;

receive a selection of reviewees from the preloaded list;

...

Applicant respectfully submits that at least these claim elements from independent claim 32 are not anticipated or rendered obvious by Dirksen, for at least similar reasons as discussed above identifying deficiencies in the applied reference with regard to independent claim 10. Accordingly, Applicant respectfully submits that claim 32 is also patentably distinct from the cited reference.

Furthermore, Applicant submits that claims 11-16, 20-27, 29-31 and 33-40, which depend directly or indirectly from independent claims 10, 19, 28 and 32 respectively, are also not anticipated or rendered obvious by Dirksen, for at least similar reasons as those discussed above identifying deficiencies in the applied reference with regard to the independent claims. Accordingly, Applicant respectfully submits that the pending claims are patentably distinct from the cited reference.

Claim Rejections - 35 U.S.C. § 103

The Examiner's Answer and the Final Office Action rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Dirksen et al., US Patent No. 6,853,975 (hereinafter "Dirksen").

With respect to pending claim 15, the Examiner alleges:

... Dirksen et al. does not explicitly teach inputting said employee performance review information by the user while the disconnected from the communication network. However, it is old and well known in the art of communication networks to allow for work to be complete while disconnected from the Internet wherein the information can be stored and communicated over a network when there is a network connection present. This feature allows for convenience to the operator wherein he or she can

complete the rating while away from the office. (Office Action, pg. 7, § 11).

Applicant respectfully traverses this rejection and submits that a *prima facie* showing of obviousness has not been made and that the applied reference fails to discuss or render obvious the pending claim. Further, Applicant notes claim 15 is dependent on and incorporates the elements of independent claim 10. Applicant submits dependent claim 12 as well as dependent claim 15 are patentably distinct from the cited reference for at least the reasons discussed above with respect to the deficiencies in Dirksen as related to independent claim 10.

Applicant submits that the Examiner has merely asserted that "... allow[ing] for work to be complete while disconnected from the Internet..." are "old and well known," but has failed to support this assertion that the claimed element would have been well known within the context of the claim taken as a whole to one of ordinary skill in the art at the time the invention was made.

To properly support such an assertion, the Examiner must (a). provide evidentiary support (MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill"); (b). establish the appropriate indication of ordinary skill in the art (MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill."); and (c) provide an objective rationale for modifying and/or using the applied references and/or the official notice (MPEP §2141 (III) states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been

obvious”), making all such assessments without impermissible hindsight, picking and choosing, mischaracterizations and over-generalizations.

(a). Evidentiary Support. Applicant submits that the Examiner fails to provide explicit evidentiary support as to why the relevant claim elements of the noted claims would be allegedly old and well known to one of ordinary skill in the art at the time the invention was made. Per MPEP § 2144.03.A, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known” (emphasis original). Applicant respectfully submits that the Examiner fails to provide explicit evidentiary support as to why “... allow[ing] for work to be complete while disconnected from the Internet...” would be allegedly obvious to one of ordinary skill in the art at the time the invention was made, as required by the MPEP.

(b). Indication of the level of ordinary skill. In addition to the aforementioned lack of evidentiary support, Applicant further submits that impermissible hindsight has been applied in asserting obviousness of the various claim elements without citing prior art or providing an indication of the level of ordinary skill. MPEP § 2141 (II)(C) states, “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.” The pending rejection refers to, “... it is old and well known in the art of communication network ...,” (Office Action, pg. 7, § 11) but has provided no indication or discussion of the level of ordinary skill associated therewith. The rejection’s reference to “the art of communication network” is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP

§ 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicant is unclear as to what the Examiner considers the level of ordinary skill to be and, thus, are not in a position to provide a complete reply that is most suited to addressing the Examiner's concerns. As no indication of the level of ordinary skill has been provided, Applicant submits that the rejection applies impermissible hindsight and has not made a *prima facie* showing of obviousness. Should the Examiner maintain the rejection, Applicant respectfully requests that he discuss the level of ordinary skill alleged to be associated therewith at the time of the invention, and clarify why he believes the claimed subject matter would have been obvious to one possessing that level of skill.

(c). Objective Rationale. Applicant submits that the pending rejection has not provided sufficient objective rationale for modifying the applied reference. By way of example only, Applicant notes that the pending rejection alleges, "this feature allows for convenience to the operator wherein he or she can complete the rating while away from the office" (Office Action, pg. 7, § 11). Applicant respectfully submits that the alleged rationale for the proposed modifications of the applied references provided for the pending rejection are overly general. Applicant is unclear how the Examiner believes it is obvious to one of ordinary skill in the art to modify Dirksen. Applicant submits that merely alleging utility, without providing any attendant explanation or articulation of how that alleged utility points beyond the reference to the modification of the reference proposed in the pending rejection, is insufficient to support an assertion of obviousness under 35 U.S.C. § 103. MPEP §2141 (III) states, *inter alia*, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the

reason(s) why the claimed invention would have been obvious,” and that, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Applicant submits that, by providing alleged utility of the Examiner’s conclusionary assertion, the pending rejection has failed to provide a “clear articulation of the reason(s)” or an “articulated reasoning with some rational underpinning” for the proposed modification of the reference. Applicant further requests that the Examiner clarify exactly why he believes the specific modification, taken in relation to the claims as wholes, would allegedly have been obvious to one of ordinary skill in the art at the time the invention was made.

As such, Applicant respectfully requests reconsideration and withdrawal of the pending rejection.

CONCLUSION

Consequently, the reference(s) cited by this Office Action and/or any previous office action(s) (hereinafter “Office Action(s)”) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 10-16 and 19-40, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore,

Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to any Office Action(s) objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-480. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-480.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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